

REMARKS

Claims 1 through 14 were rejected as indefinite based upon indefiniteness of individual claims 1 and 14. In that regard, each of claims 1 and 14 has been amended, and as amended those claims are believed to overcome the alleged indefiniteness.

Claims 1, 2, and 12 through 14 were rejected as anticipated by the Yamano et al. '491 patent. In the course of discussing the reference, the examiner characterized element 7 of that reference as a toothed rack. However, that element is identified in the reference as an externally threaded propulsion screw. And it includes a fixed gear 6 at one end and engages with an internally threaded propulsion screw at its other end. ** make toothed rack claim 819*

Clearly, the structure shown and described in the Yamano et al. '491 reference, which is directed to a lifting apparatus, not to an actuator for actuating an automatic clutch or an automatic transmission, is significantly structurally and operationally different from the invention as claimed in claim 1 of the present application. Specifically, in addition to a toothed rack and not an externally threaded screw, the invention as claimed in claim 1 includes a gear that is in meshing engagement with the toothed rack. The Yamano et al. '491 reference does not show or suggest a gear in meshing engagement with a rack. Instead, it shows a gear 6 carried on the end of a threaded propulsion screw 7, wherein gear 6 is in meshing engagement with a helical gear 27. Neither of gears 6 or 27 moves screw 7 linearly within cylindrical member 11, which is the type of movement claimed in claim 1, but merely rotates it so that it can move

internally threaded propulsion rod 9, and entirely different structural arrangement from that claimed herein. And finally, the Yamano et al. '491 reference does not disclose an arrangement in which an electric motor and a gear that engages a toothed rack are provided as a pre-assembled unit that is removably connected with a housing that includes an axially-extending first receptacle, as claimed in claim 1. In fact, as illustrated in Figures 1 through 3 of Yamano et al. '491, the structure involves a unitary, integrally formed housing, not one involving separate receptacles, as claimed. Consequently, the Yamano et al. '491 reference neither shows nor suggests the claimed invention.

*does have
1st & 2nd
receptacles*

Claims 2 and 12 through 14 each depend from claim 1, and therefore the same distinctions as are noted above in connection with claim 1 apply with equal effect to each of those dependent claims. Additionally, those dependent claims recite additional structural features that further distinguish the invention as so claimed in those claims from the teachings of the Yamano et al. '491 reference.

Claims 1 through 11 were rejected as obvious based upon the Piao '915 reference in view of the Unger '651 reference. Those references are drawn from non-analogous arts in that Piao '915 relates to a water flow control device and Unger '651 relates to a motorized seat belt adjustment system. And although the examiner recognized that Piao '915 discloses an actuating arrangement that includes a rack, she acknowledged that that reference does not disclose that the motor and gear are provided as a pre-assembled unit. Additionally, as was the case with the Yamano et al. '491 reference, the Piao

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been used*

'915 reference shows a unitary, integrally-formed housing, not one involving separate receptacles as claimed. The Unger '651 reference was cited for allegedly showing a pre-assembled motor and gear unit.

At the outset, Unger '651 does not show or suggest first and second receptacles, wherein a toothed rack is movably carried within the first receptacle and a motor and gear are carried within the second receptacle, as claimed in claim 1. Instead, Unger '651 shows a unitary receptacle, in the form of a track 60 that includes a rack 65 formed on one inner surface of the track, not first and second receptacles for a rack and for a motor and gear. The Unger '651 reference teaches a stationary rack, and a motor carried on a base 44 that travels along the stationary rack within the unitary receptacle.

Because the Piao '915 and Unger '651 references are drawn from entirely different fields from that to which the claimed invention is directed, it is not at all apparent why one faced with a space problem involving a motor vehicle clutch or transmission actuator would look to the water flow control art or to the seat belt motor art for inspiration. And even if one having only ordinary skill in the art had before him the Piao '915 and Unger '651 references, there is no teaching or motivation as to which elements from which reference should be combined with which elements from the other reference, and which elements are to be ignored or discarded. In fact, the only motivation for combining the references as the examiner has done is the present disclosure. And to use against an inventor that which only he has taught involves an improper hindsight reconstruction of the prior art while using the inventor's disclosure as a road map

or a template with which to piece together disparate parts of disparate references.

Claims 2 through 11 each depend from claim 1, and therefore the same distinctions as are noted above in connection with claim 1 apply with equal effect to each of those dependent claims. Additionally, those dependent claims recite additional structural features that further distinguish the invention as so claimed in those claims from the teachings of the Piao '915 and Unger '651 references.

Claims 1, 2, and 11 through 13 were rejected as obvious over Cotter '290 in view of Unger '651 and Darnell '593. The Cotter '290 reference, which is directed to a lifting apparatus, was cited for showing an actuator including a toothed rack, but was acknowledged to be deficient in that it did not disclose an electric motor or that an electric motor and gear are provided as a pre-assembled unit. In that regard, the Darnell '593 reference was cited for showing an electric-motor-driven rack arrangement for a lifting device. And the Unger '651 reference, which discloses a fixed rack and a movable motor, not a movable rack driven by a motor and gear that are carried in a second receptacle that is separate from a first receptacle within which the rack is movable, was relied upon for showing a motor coupled with a gear as a pre-assembled unit. Neither of the three references individually shows or suggests the claimed invention. And again, the references relied upon in support of this ground for rejection are drawn from entirely different fields from that to which the claimed invention relates. And in that regard it is not apparent why one faced with a

space problem involving a motor vehicle clutch or transmission actuator would look to the lifting device art or to the seat belt motor art for inspiration in solving such a motor vehicle space limitation problem.

Even if one having only ordinary skill in the art had before him each of the Cotter '290, Unger '651, and Darnell '593 references, there is no teaching or motivation in any of those references that would lead one having only ordinary skill in the art to take particular elements from one reference and combine them with particular elements from either of the other references. Nor is there any teaching or suggestion concerning which elements of which references are to be ignored or discarded. Again, the only motivation for combining those three references as the examiner has done is the present disclosure. And to use against an inventor that which only he has taught involves an improper hindsight reconstruction of the prior art while using the inventor's disclosure as a road map or a template with which to piece together disparate parts of disparate references.

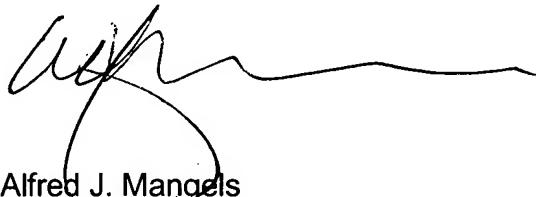
Claims 2 and 11 through 13 each depend from claim 1, and therefore the same distinctions as are noted above in connection with claim 1 apply with equal effect to each of those dependent claims. Additionally, those dependent claims recite additional structural features that further distinguish the invention as so claimed in those claims from the teachings of the Cotter '290, Unger '651, and Darnell '593 references.

Based upon the foregoing amendments and remarks, the claims as they now stand in the application are believed clearly to be in allowable form. The

claims are patentably distinguishable over the teachings of the references relied upon, whether those references be considered in the context of 35 U.S.C. § 102 or of 35 U.S.C. § 103. Additionally, the combinations of the references are urged to be improper in that there is no motivation for any such combination of those references apart from the disclosure in the present application. Consequently, this application is believed to be in condition for allowance, and reconsideration and reexamination of the application is respectfully requested with a view toward the issuance of an early Notice of Allowance.

The examiner is cordially invited to telephone the undersigned attorney if this amendment raises any questions, so that any such question can be quickly resolved in order that the present application can proceed toward allowance.

Respectfully submitted,



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Alfred J. Mangels
Reg. No. 22,605
4729 Cornell Road
Cincinnati, Ohio 45241
Tel.: (513) 469-0470